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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,227	12/29/2000	Joseph E. Johnson	97078CIPDIV1	5132
7590 10/28/2003			EXAMINER	
Cabot Corporation Law Department 157 Concord Road Billerica, MA 01821			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/752,227

Applicant(s)

JOHNSON ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 65-67, 70-72, and 86.Claim(s) objected to: 58-64.Claim(s) rejected: 57 and 80-85.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Callie E. Shosho  
Primary Examiner  
Art Unit: 1714

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejections of record set forth in paragraphs 3, 5, and 7-8 of office action mailed 4/29/03.

**Attachment to Advisory Action**

1. Applicants' amendment filed 9/29/03 has been fully considered.

The amendment is successful in overcoming the rejections of record as set forth in paragraphs 3, 5, 7, and 8 of the office action mailed 4/29/03.

The amendment is not successful in overcoming the rejection of record utilizing Hall et al. (U.S. 5,552,458) or the rejection of record utilizing Whitehouse et al. (U.S. 6,337,358) in view of Belmont et al. (U.S. 5,571,311) as set forth in paragraphs 4 and 9, respectively, of the office action mailed 4/29/03. It is noted that applicants are correct in stating that in paragraph 9 of the office action mailed 4/29/03 the correct patent number for the Whitehouse et al. reference is U.S. 6,337,358.

With respect to Hall et al., applicants argue that the reference does not anticipate claim 57 as amended. It is noted that present claim 57 requires pigment having attached aromatic or alkyl group X that is substituted with polymer wherein X is directly attached to the pigment and wherein the polymer is polycarbonate, polyether, polyimide, polyurethane, polyamide, polyester, or polyvinyl alcohol.

Hall et al. disclose pigment having attached group of the formula  $R^2-Si-AX$  where  $R^2$  is a  $C_1-C_{10}$  alkyl group and X is attached to polymeric backbone wherein the polymers include polyurethane and polyester.

Thus, given that Hall et al. disclose pigment having directly attached alkyl group  $R^2$ , corresponding to presently claimed group X, which is substituted with polymer which is polyamide or polyester, identical to the polymers presently claimed, it is the examiner's position that Hall et al. does meet the requirements of claim 57.

With respect to Whitehouse et al. in view of Belmont et al., applicants' argue that there is no motivation to combine Whitehouse et al. with Belmont et al. given that there is no disclosure in Belmont et al. of modified pigment having attached polymer as presently claimed.

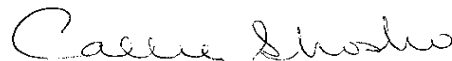
However, note that Belmont et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely specific types of binders used in ink jet inks, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Applicants also argue that it would not have been obvious to one of ordinary skill in the art that an additional polymer could be added to ink jet ink comprising modified pigment which also has attached polymeric group and that this combination would result in composition that would still function as an ink jet ink.

It is noted that Whitehouse et al. disclose ink jet ink comprising liquid vehicle, modified pigment having attached polymer, and binder. However, there is no disclosure of the specific binders utilized which is why Whitehouse et al. is used in combination with Belmont et al., which is also drawn to ink jet ink, and disclose the use of binder identical to that presently claimed such as polyester, styrene –acrylic acid copolymer, polyester-melamine, etc. Given that Belmont et al. is drawn to the same field of endeavor as Whitehouse et al. and discloses the use of specific types of binders that are already generically disclosed by Whitehouse et al., it is the

examiner's position that there is proper motivation to combine Whitehouse et al. with Belmont et al.

Further, it is the examiner's position that it would have been obvious to one of ordinary skill in the art that the addition of an additional polymer to ink jet ink composition comprising modified pigment having attached polymer would result in composition that would still function as an ink jet ink given that it is the primary reference itself, namely Whitehouse et al., which discloses using such combination of modified pigment having attached polymer with binder or additional polymer. Belmont et al. is not used to teach the use of additional polymer in the ink jet ink of Whitehouse et al. Rather, Belmont et al. is only used to teach specific types of binders already generically disclosed by Whitehouse et al.



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CS  
10/23/03